

Morrison '505 fails to teach or suggest the recited "first and second supporting surfaces of each retractor arm being laterally displaced with respect to each other" and "distracting the adjacent vertebrae by at least partially inserting the retractor arms of the retractor within the intervertebral space whereby the first supporting surface of each retractor arm engages one vertebrae and the second supporting surface of each retractor arm engages the other vertebrae such that the adjacent opposed vertebrae are laterally displaced" as recited in independent claim 2. In contrast, with the Morrison '505 device, the tips 12 of arms 11 are inserted in a manner whereby only one tip and associated arm engages an upper vertebra and the other tip and associated arm engages the lower vertebra. (See FIG. 2 of the Morrison '505 patent.) Accordingly, in light of this distinction, *amongst others*, withdrawal of this rejection is respectfully requested.

Claims 12-18 and 27 stand rejected under 35 U.S.C. §102(b) by U.S. Patent No. 3,867,932. Huene '932 relates to an assembly for inserting rigid shafts or pins to join bone segments of a fractured bone. The assembly incorporates a clamp 14 and a movable jaw 34 which is inserted in the clamp 14. The movable jaw 34 includes a cylindrical body 35 which is bifurcated at its distal end to define a pair of teeth 38 having sharpened tips which penetrate bone. The movable jaw 34 is provided with a bore 44 which serves as a bearing surface to receive a drill, etc...

It is respectfully submitted that the present invention as claimed is patentably distinguishable from Huene '932 and is therefore allowable thereover. Firstly, the Huene '932 device is not a surgical retractor as is Applicants' invention as claimed in each of independent claims 12, 15, 18 and 27, but, rather is a movable jaw structure (e.g., a drill

sleeve) which serves as a bearing surface for instruments which are inserted therein. The phrase "retractor", which first appears in the preamble of Applicants' claim, is an affirmative structural limitation of Applicants' claim when taken in view of the specification and drawings of the application. (The preamble of a claim constitutes a limitation when it gives meaning to the claim and serves to define the invention. *Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2d 888, 896, 221 USPQ 669, 675 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 857 (1984)). (A copy of the *Perkin-Elmer* case is enclosed herewith.) Applicants' device is described throughout the specification and claims as an instrument which is used to engage or distract opposed tissue portions, e.g., adjacent vertebrae, to permit the performance of a surgical orthopedic procedure adjacent the distracted tissue portions. In contrast, the movable jaw 34 of the Huene '932 device is not a retractor and does not perform any distracting function, but, rather, is a conventional drill sleeve with teeth at its end which are driven into bone to mount the jaw 34 to the bone.

Even if, *assuming arguendo*, Applicants' retractor as claimed and the Huene movable jaw 34 are similar in structure, it is submitted that the fundamental differences in use and application of Applicants' device (i.e., as a surgical retractor as recited in the claims) and the Huene movable jaw 34 would preclude an interpretation that the Huene movable jaw 34 anticipates Applicants' invention as claimed. For support of this proposition, Applicants direct the Examiner's attention to the recent Federal Circuit decision in *Rowe v. Dror*, 42 USPQ 1550 (Fed. Cir. 1998). In *Rowe*, the Federal Circuit held that a balloon angioplasty catheter was not anticipated by a prior art reference disclosing a conventional surgical balloon catheter having identical structure. The court further proposed that the phrase "balloon

"angioplasty catheter" which appeared only in the preamble of the claim, was an affirmative structural limitation of the Applicants' claimed invention in that language in the specification limited such language to mean catheters that can be inflated radially outward to dilate a narrowed region in a blood vessel, and thus was not anticipated by the patent directed to a general purpose surgical balloon catheter having identical structure. (A copy of the *Rowe* decision is enclosed herewith).

Thus, in view of the foregoing, it is submitted that Huene '832, which is not a retractor, does not anticipate Applicants' invention as claimed.

In addition, with further regard to independent claim 12, the Huene '832 device fails to teach or suggest Applicants' recited "first and second retractor arms extending in a general longitudinal direction, each retractor arm defining a dimension between the first and second supporting surfaces sufficient to distract the opposed tissue portions upon insertion thereof". As indicated above, the teeth 38 of the movable jaw 34 of the Huene device are not retractor members but rather are narrow elements with sharpened ends to penetrate bone. With further regard to independent claim 15, Huene '832 fails to teach or suggest the recited "first and second vertebra supporting surfaces of each retractor arm being spaced a predetermined distraction distance at least equal to the height of the intervertebral space defined between the adjacent vertebrae." As indicated above, the teeth 38 of the Huene '832 device are not "retractor arms". Moreover, the teeth 38 do not define a distraction distance at least equal to the height of the intervertebral space, but rather are narrow in dimension such that they may enter hard bones. With further regard to independent claim 18, Huene '832 does not teach or suggest the recited "first and second

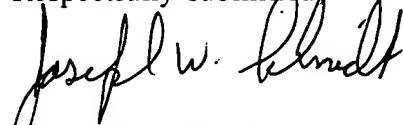
supporting surfaces of each retractor arm being spaced a predetermined distraction distance at least equal to the height of the intervertebral space" for reasons discussed in connection with the discussion of claim 15. With further regard to independent claim 27, Huene '832 fails to teach or suggest the recited "each retractor arm having opposed distracting surfaces spaced at a predetermined distraction distance sufficient to distract the opposed tissue portions upon insertion thereof".

Accordingly, in view of the foregoing, withdrawal of this rejection is respectfully requested.

It is respectfully submitted that none of the references of record disclose or suggest the present invention as claimed in the claims as amended, considered individually or in combination, with themselves, considered in whole or in part. Accordingly, withdrawal of the rejections is respectfully requested.

In view of the foregoing amendments and remarks, reconsideration of the rejections and objections and allowance of the claims are earnestly solicited.

Respectfully submitted,



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